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NOV 05 2004

In re Application of	:	
Smith et al.	:	OFFICE OF PETITIONS
Application No. 08/392,934	:	NOTICE REGARDING
International Filing Date:	:	IMPROPER REQUEST
September 15, 1993	:	FOR CONTINUED
371 Date: October 28, 1996	:	EXAMINATION (RCE)
Title of Invention:	:	
IMMUNOREACTIVE PEPTIDES FROM	:	
EPSTEIN-BARR VIRUS	:	

Background:

Applicant filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on December 18, 2001, in the above-identified application, which is the National Stage of an International Application filed on September 15, 1993. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure (MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on June 28, 2001. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on December 18, 2001, did not toll the

time period set forth in the Office action mailed on June 28, 2001. Thus, the application became **abandoned** on **December 29, 2001** for the failure to reply to the final Office action mailed on June 28, 2001.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A Supplemental Response was filed December 18, 2001. A non-final Office action was mailed on March 8, 2002. A reply to the non-final Office action was filed on August 12, 2002. An Ex Parte Quayle action was mailed October 29, 2002. An Amendment in response to the Ex Parte Quayle action was filed on December 2, 2002. A Notice of Allowance was mailed on February 20, 2003. The Office regrets the delay in notifying Applicant of this error.

Applicants may file a petition under 37 CFR 1.137(b) to revive the application within **two (2) months from the date of this Notice. This time period may not be extended.** The required reply under 1.137(c) is the issue fee, which was filed on May 22, 2003. The petition must be accompanied by a terminal disclaimer and fee as set forth in 37 CFR 1.321 because the application was filed before June 8, 1995. See 37 CFR 1.137(d).


Any petition under 37 CFR 1.137(b) should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 220 20th Street S.
 Customer Window
 Crystal Plaza Two, Lobby Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this Notice should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney Advisor
Office of Petitions